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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,549	06/26/2001	Anthony J. Berejka	438 P 892	1871

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EXAMINER

FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,549

Applicant(s)

BEREJKA ET AL.

Examiner

Michael J Feely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44-51 and 53 is/are allowed.
- 6) ☒ Claim(s) 1-43, 52, 54 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed February 19, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant has amended the claim language to limit the quantity of the bisphenol-A derivative to more than 25 wt%.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. The rejection of claims 11-14 and 39-43 under 35 U.S.C. 112, second paragraph, has been overcome by amendment.

4. Claims 52, 54, and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 52 recites the limitation "the hydroxy functional compound" in the curable blend according to claim 50. There is insufficient antecedent basis for this limitation in the claim. It appears that this claim should limit claim 51.

6. Claims 54 and 55 recite limitations for "A coated substrate according to claim 52". There is insufficient antecedent basis for this limitation in the claim. Claim 52 is drawn to a curable blend. It appears that these claims should limit claim 51.

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7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended the claim language to limit the quantity of the bisphenol-A derivative to more than 25 wt%. Applicant has cited Examples I through V as support for these changes; however, it should be noted that Example II includes the bisphenol-A derivate in quantities *above and below* 25 wt%. The Specification is silent regarding *any* specific concentration of the bisphenol-A derivative, including the newly claimed range of more than 25 wt%. Furthermore, the Specification fails to show criticality for a lower limit of 25 wt%. This lower limit is not discussed in the body of the Specification, and the Examples fail show how this end point is required for the instant invention.

For the reasons set forth above, it has been determined that the inclusion of this range is not supported by the Specification; hence, the change constitutes new matter.

Claim Objections

9. The objection to claims 40 and 41 has been overcome by amendment.

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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11. The rejection of claims 1-3, 8, 11, 23-24, 25-27, 32, and 37-38 under 35 U.S.C. 102(b) as being anticipated by Marks et al. (US Pat. No. 4,421,806) has been overcome by amendment.

The change to these claims regarding the quantity of the bisphenol-A derivative overcomes the prior art; however, this change constitutes new matter. It should be noted that if this new matter is removed, the claims would be subject rejection under 35 U.S.C. 102(b) over Marks et al. for the reasons set forth in section 7 of the previous Office action.

Claim Rejections - 35 USC § 102/103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. The rejection of claims 4-5 and 28-29 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Marks et al. (US Pat. No. 4,421,806) has been overcome by amendment.

The change to these claims regarding the quantity of the bisphenol-A derivative overcomes the prior art; however, this change constitutes new matter. It should be noted that if this new matter is removed, the claims would be subject rejection under 35 U.S.C. 102(b) or 35 U.S.C. 103(a) over Marks et al. for the reasons set forth in section 9 of the previous Office action.

Claim Rejections - 35 USC § 103

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. The rejection of claims 39-40, 42, and 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al. (US Pat. No. 4,421,806) has been overcome by amendment.

The change to these claims regarding the quantity of the bisphenol-A derivative overcomes the prior art; however, this change constitutes new matter.

16. Claims 1-3, 8, 10-14, 21-22, 25-27, 32, 34-36, and 39-41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Victor et al. (US Pat. No. 6,127,094).

The above claims stand rejected for the reasons set forth in section 11 of the previous Office action. In addition, Victor et al. disclose the new matter limitation: the quantity of bisphenol-A derivative of more than 25 wt% (column 7, lines 10-16).

17. Claims 4-5 and 28-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Victor et al. (US Pat. No. 6,127,094) in view of Marks et al. (US Pat. No. 4,421,806).

The above claims stand rejected for the reasons set forth in section 12 of the previous Office action. In addition, Victor et al. disclose the new matter limitation: the quantity of bisphenol-A derivative of more than 25 wt% (column 7, lines 10-16).

Response to Arguments

18. Applicant's arguments with respect to Marks et al. have been considered but are moot in view of the new ground(s) of rejection.

19. In response to applicant's argument that Victor et al. fail to show certain features of Applicant's invention, it is noted that the features upon which applicant relies (i.e., that the 1,2-polybutadiene polymers of instant invention have pendant 1,2-vinyl functionality, and even when used as copolymers with 1,4-polybutadiene, the diene structures are not conjugated) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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20. In addition, Applicant argues that the 1,2-polybutadiene material used in Victor et al. would not yield a homogeneous blend because the use of some components is *optional*, and that this optional use is, “*most likely* because their use with ethyl acrylate polymers would lead to inoperative system.” The basis for this argument is unclear and appears to be speculative.

Applicant concludes this argument by implying that hindsight reasoning has been used, yielding an improper rejection. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Allowable Subject Matter

21. Claims 6-7, 9, 15-20, 30-31, 33, and 39-43 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

22. Claims 44-50, 51, and 53 are allowed.

23. Claims 52, 54, and 55 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Regarding claims 6-7, 9, 15-20, 30-31, 33, if Applicant were to correct the new matter issue in these claims, the subject matter would be allowable for the reasons set forth in section 13

of the previous Office action. However, it should be noted that these claims (*not including the new matter limitation*) have already been rewritten in independent form as new claims 44-55, and caution should be used to avoid submission of duplicate claims.

Regarding claims 39-43, if Applicant were to correct the new matter issue in these claims, the subject matter would be allowable because Marks et al. fail to teach or suggest a coating process of claim 39, wherein the coating material is cured by exposure to radiant energy.

Regarding claims 44-55, these claims represent the rewritten version of original claims 6-7, 9, 15-20, 30-31, 33. They are allowable for the reasons set forth in section 13 of the previous Office action.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Feely whose telephone number is 703-305-0268. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Michael J. Feely
April 21, 2003

A handwritten signature in cursive script that reads "Robert Dawson".

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700